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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,400	11/20/2003	Shigeki Muramatsu	Q78515	5535
23373	7590	09/30/2005	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			BEATTY, ROBERT B	
			ART UNIT	PAPER NUMBER
			2852	

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/716,400

Applicant(s)

MURAMATSU, SHIGEKI

Examiner

Robert Beatty

Art Unit

2852

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-8 is/are rejected.
- 7) ☒ Claim(s) 4 and 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. The abstract of the disclosure is objected to because on line 14, "means" constitutes legal terminology. Correction is required. See MPEP § 608.01(b).
3. Claim 4-5 are objected to because of the following informalities:
the last 4 sentences are awkwardly phrased;
in claim 5, line 4, "inciding" is awkward;
Appropriate correction is required.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1,2 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshizawa et al.

Yoshizawa et al. teach an image forming system having an image reading apparatus comprising a platen 2 having an original document 10 laid thereon, a

light source 1 for illuminating the original through a slit , a mirror unit 4 for reflecting the image light to a focusing lens 5 and finally to an image sensor 9 (see Fig.2). The mirror unit and lens move in an auxiliary direction. As seen in Figs 10(A) - 10(C), light coming from the lens can be reflected by a mirror 70 which is rotatable, to any of mirror combinations 73,79 or 74,72,78 or 75,72,76,72,77 to a rotatable mirror 71 and finally to the image sensor. A control unit controls the rotation of these mirrors(via a motor) according to a selected magnification from an operation panel. Accordingly, by varying the mirror combination, one varies the optical length, and in consequence varies the magnification. Specifically, Yoshizawa teach everything claimed except the magnification varying mirror combinations being located before the image light enters the focusing lens. In addition, the original being held out of contact with the platen is not taught.

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made that whether the magnification (optical length) varying mirror combinations are located before or after the focusing lens has no effect on the operation of the apparatus and such would be an equivalent structure in view of the fact that the applicant has not assigned any criticality to the magnification varying mirror being located before the focusing lens. In addition, the use of a holder for holding an original (such as film) out of contact with the platen is notoriously well known in the art for the purpose of making it easier to duplicate not easily handled originals of which the examiner takes Official Notice.

5. Claims 3,8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshizawa et al. in view of Yeh.

Yoshizawa et al. taught supra discloses most of what is claimed except the image sensor, lens, and the reflecting mirrors are located in a single movable module which moves in the auxiliary direction. Yeh teach an image forming apparatus having a reading device comprising mirrors, 171-174, lens 18 and image sensor 19 located in a frame module 14 which moves in the auxiliary direction in order to scan the original documents. It would have been obvious to one of ordinary skill in the art at the time the invention was made to place the components in Yoshizawa et al. in a module because easy replacement or refurbishment of the components can be accomplished.

6. Claims 4,5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wu et al., Nagane, Suzuki, Shieh et al., Kaneko et al., and Tokuhara (JP) all teach various image reading apparatus with magnification varying means and optical path related to such.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Beatty whose telephone number is (571) 272-2130. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur Grimley, can be reached on (571) 272-2136. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "Robert Beatty", with a stylized, cursive script.

Robert Beatty
Primary Examiner
Art Unit 2852

September 29, 2005